

## REMARKS

### **I. Status**

Claims 1, 3, 4, 6-15, 55, 56, 58, 60-62, and 64 – 67 are pending.

Claims 1, 3, 4, 6-15, 55, 56, 58, 60-62, and 64 – 67 stand rejected.

### **II. Rejection Under 35 USC §103(a)**

The Examiner rejected Claims 1-15 and 55-69 under 35 U.S.C. 103(a) as being unpatentable over Leatherman (U.S. Patent No. 5,544,044), in view of Johnson (USP No. 4,987,538 and further in view, StellarNet Releases First Internet Based Claims Verification Product For Worker's Compensation Industry by Robert McCaffery (PR Newswire, New York, November 11, 1999).

In support of the rejection, the examiner alleges that neither Leatherman nor Johnson explicitly disclose "a" matching worker's compensation number "associated with said data"; "and" "or" "automatically sends" "determining" "to a selected one of a plurality of payer computers". The applicant agrees and essentially argued this point in the earlier office action. However, the examiner now points out that McCaffery suggests a matching worker's compensation number "associated with said data"; "and" "or" "automatically sends" "determining" "to a selected one of a plurality of payer computers" and therefore the invention is obvious to one of ordinary skill in the art given the combination of references cited. However, as the attached Declaration hereby submitted in accordance with 37 U.S.C. 1.131 indicates, the inventors were Stellarnet employees. They had conceived and reduced to practice the invention before the McCaffery press release of November 11, 1999 announcing the existence of the invention. Therefore, since as admitted by the examiner, McCaffery is the linchpin to sustain the 103 rejection, it fails as a reference in the present 103 rejection.

The examiner has rejected each of the dependent claims based on a rejection of the independent claim from which they depend. Accordingly, the applicant's remarks made in response to independent claims 1 are also applicable in response to the rejection of each of the

dependent claims 3-15. In view of the remarks made with regard to the rejection of claims 1, which are repeated herein in response to the rejection of the dependent claims, applicant respectfully submits that the examiner's rejection of the dependent claims can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of each of the dependent claims.

With regard to independent claims 55, 56, and 60, the examiner rejected these claims essentially citing the same references used in rejecting claim 1. Accordingly, the remarks made with regard to the rejection of claim 1, which are applicable to, and repeated as if in their entirety, to overcome the rejection of claims 55, 56, and 60 applicant submits these claims are also not obvious, and allowable, in view of the references cited.

Applicant submits that the dependent claims of independent claims 55, 56 are also not obvious, and are allowable, by virtue of their dependence upon an allowable base claim. The examiner has rejected dependent claims 58-62, and 64-67 based on a rejection of the independent claim from which they depend. Accordingly, the applicant's remarks made in response to independent claims 1 and 55, 56 are also applicable in response to the rejection of each of the dependent claims 58-62, and 64-67. In view of the remarks made with regard to the rejection of claims 1 and 55, 56, which are repeated herein in response to the rejection of the dependent claims, applicant respectfully submits that the examiner's rejection of the dependent claims can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of each of the dependent claims.

#### **IV. Conclusion**

It has been shown that the claimed invention is distinguished over the express and implied teachings of the prior art cited of record in the application, and in particular, is distinguished over the express and implied teachings of Leatherman in view of Johnson and in view of McCaffery given the submission of a declaration per 37 CFR 1.131. Having addressed the examiner's rejections of the claims under 35 USC §103, applicant submits that the reasons for the examiner's rejection have been overcome and can no longer be sustained. Applicant


respectfully requests reconsideration, withdrawal of the rejections and that a Notice of Allowance be issued.

If the examiner believes that unresolved issues associated with this response may be resolved in an expeditious manner, the Examiner is invited to call Applicant's attorney at the telephone number indicated below.

**V. Fees**

No fees are believed necessary for filing this amendment. However, if any fees are deemed needed, the Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to Duane Morris LLP deposit account **04-1679**.

Respectfully submitted,

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ATTACHED:

**DECLARATION OF SHERYL LEE WILSON AND JOHN R. STEVENS**